



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,083	07/14/2003	Ping Huang	034536-0318	3626
22428	7590	06/28/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			PATEL, SUDHAKER B	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,083	<b>Applicant(s)</b> HUANG ET AL.	
	<b>Examiner</b> Sudhaker B. Patel, D.Sc.Tech.	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>6/18/04</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____.   |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims (in part) 1-13,14,15,16,17,18,20,21,31-33,36,39,42, drawn to compounds, simple compositions, a single specific method of use of Formula (I) with a core:" substituted phenyl-A1-substituted phenyl, classified in nonheterocyclic chemistry class 564,568, subclasses various depending on the nature of the substituentsQ, R1, A1 R2 and integer. If this groups is elected further restriction/election will be required as there are many unknowns. Additionally, a single species from the working examples must be disclosed with exact and definite meanings for the variables recited in the Formula (I).

**Applicants had elected invention of Group I for the parent**

**U.S.Application Sr. # 09645879, filed 8/25/00, now U.S.P. 6596772.**

- II. Claims (in part) 1-13,16,19 -30,34,35,37-41,43-47 compounds, simple compositions, a single specific method of use of Formula (II) with a core:" substituted bicyclic fused ring (having phenyl-B)-A2-substituted phenyl, wherein B is aryl, carbocyclic, heteroaryl, heterocyclic which may be substituted or unsubstituted, drawn to heterocyclic chemistry, classified in various classes e.g. 540-549, subclasses various depending on the nature of variables Q, R1, A2, R2 and integer n. If this groups is elected further

restriction/election will be required as there are many unknowns.

Additionally, a single species from the working examples must be disclosed with exact and definite meanings for the variables recited in the Formula (II).

- III. Claims (in part) 1,10,11,12,16,21,39,48, drawn to compounds, simple compositions, a single specific method of use of Formula (III), and method of uses not included in above recited inventions I, II, classified in classes consisting of non-heterocyclic chemistry when B is aryl or carbocyclic or heterocyclic chemistry when B is heteroaryl or heterocyclic, classified in various heterocyclic chemistry classes and subclasses depending on the nature of the variables Q, R1 and integer n. As stated earlier, this group will additionally consists of the methods involving other treatment(s) of diseases not included in inventions I & II. If this groups is elected further restriction/election will be required as there are many unknowns.
- Additionally, a single species from the working examples must be disclosed with exact and definite meanings for the variables recited in the Formula (III), and method(s) of uses not included inventions II & I.

The inventions are distinct, each from the other because of the following reasons:

The compounds of inventions of Groups I-III are drawn to:

- (1). Structurally diverse/dissimilar compounds that are made and used independently of each other;
- (2). Compounds are separately classified;

- (3) Inventions will require separate literature searches;
  - (4) Compounds are not art recognized equivalents, and additionally,
  - (5). The groups lack unity of invention(see MPEP 803.02).
- Based on above stated data i.e. (1) - (5)., claim 1 also lacks unity of invention.

2. Inventions I-III are related as groups consisting of product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case compounds of WO 9586376 can also be used for the utility as claimed herein.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-III, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Claims 1,10,11,12,16,21,39,48 are generic to a plurality of disclosed patentably distinct species comprising (1). compounds of generic Formula (I). (2). Compounds of generic Formula(II). (3). Compounds of generic Formula(III), and other method(s) of using not included in Groups I & II. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

Art Unit: 1624

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. .

6. A telephone call was made to ATTY.Ms B. Burrous on 6/18/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is (571) 272-0671.

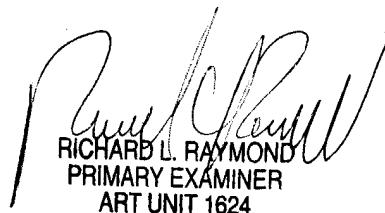
9. The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on (571) 272 0674 or Sr. Examiner Mr. Richard Raymond at (571) 272 0673 or Mr. James O. Wilson at (571) 272-0661.

Art Unit: 1624

10. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sudhaker B. Patel, D.Sc. Tech.  
June 21, 2004



RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624

MUKUND SHAH  
SUPERVISORY PATENT  
EXAMINER  
ART UNIT 1624/1623